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Paper No. 21

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MAY 14 2003

OFFICE OF PETITIONS

In re Application of	:	
Wilhelm F. Maier	:	
Application No. 09/254,525	:	DECISION ON SECOND
Filed: March 8, 1999	:	RENEWED PETITION
Attorney Docket No.: STUDIEN262-K	:	
Title: USE OF MICROPOROUS	:	
ANORGANIC MEMBRANE CATALYSTS	:	

This is a decision on the second renewed petition to withdraw the holding of abandonment filed on May 12, 2003, pursuant to 37 C.F.R. §1.181(a), as well as the concurrently filed petition pursuant to 37 C.F.R. §1.137(b)¹, to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed August 10, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 11, 2001. A Notice of Abandonment was mailed on April 4, 2002.

The original petition, filed on August 12, 2002, was dismissed via a decision mailed by the Office on December 19, 2002, for failure to submit a docket report.

¹ A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The renewed petition, filed on February 19, 2003, was dismissed via a decision mailed by the Office on March 10, 2003. The reason for dismissal was based on the premise that petitioner failed to notify the Office of his change of address, and as such, petitioner was precluded from requesting that the holding of abandonment be withdrawn.

With the instant petition, petitioner has asserted:

1. The reason for the dismissal was not supported by any case law or any portion of the MPEP
2. The dismissal “overlooks certain realities attendant with extremely large dockets²”
3. The dismissal “punished Applicant in a situation wherein Applicant’s failure was not responsible for his non-receipt of the office Action³”

Regarding the first and third arguments above, while Petitioner asserts that the abandonment may have nothing whatsoever to do with the failure to supply the new correspondence address,⁴ this is not the case. It was Petitioner’s failure to comply with MPEP 601.03 and notify the Office of his change in address which resulted in the mailing being sent to his old address. Had Petitioner correctly filed a Change of Correspondence Address, the correspondence would have been sent directly to his new location. As such was not the case, the Office mailed the correspondence to the location where it was instructed to: a location where the Petitioner no longer practiced.

Petitioner states “the Office Action dated August 10, 2001, should have been forwarded to the undersigned’s new address, and the fact that it was not should be grounds for removing the holding of abandonment⁵.” Here, the petitioner asserts that the Post office, although it usually forwarded mail from the old address to his new one, failed to do so in this particular occasion. If such is the case, this would not have occurred had the Petitioner merely promptly filed the Change of Correspondence Address in a prompt manner, as MPEP 601.03 requires practitioners to do.

Regarding the second requirement above, petitioner sets forth that due to his extremely large docket, it takes some time to communicate a change of address for such a large number of cases, and as such, although the work was started diligently and immediately, it could not have been completed contemporaneously with the move⁶.

This argument is not persuasive, for the following two reasons.

First, practitioners are not excused from complying with the above-mentioned section of the MPEP if they have large dockets.

Secondly, practitioners may have their address changed by the submission of a single form. There is no need to submit a separate form for every application on a practitioner’s docket. As such, it is not understood how the submission of a single form imposed too great of a burden to be realistically feasible.

2 Second renewed petition, page 3.

3 Id.

4 Id.

5 Id.

6 Id.

Finally, it is noted that the Final rejection was mailed on August 10, 2001, and the Notice of Abandonment was mailed on April 4, 2002. More than four months later, the original petition to withdraw the holding of abandonment was filed with the Office. Unfortunately, this submission was untimely, as it was not filed within two months of the mailing of the Notice of Abandonment⁷.

As such, the petition under 37 C.F.R. §1.181(a) is **DISMISSED**.

Regarding the petition under 37 C.F.R. §1.137(b), the petition is **GRANTED**.

With the instant petition, petitioner has submitted a Notice of Appeal, an amendment, has made the proper statement of unintentional delay, and has submitted both the petition fee and the fee associated with the filing of a Notice of Appeal⁸.

The Notice of Appeal filed on May 12, 2003, has been entered and made of record. **Accordingly, the two (2) month period for filing the Appeal Brief, in triplicate, accompanied by the fee required by law, runs from the mailing date of this decision.**

The application file is being forwarded to Technology Center 1700 for further processing of the Notice of Appeal filed concurrently with this petition.

Telephone inquiries *specific to this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanoski
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Office of Petitions
United States Patent and Trademark Office

⁷ See MPEP 711.03(c) and 37 C.F.R. §1.183(f).

⁸ Both fees have been charged to petitioner's Deposit Account, as authorized in the second renewed petition.